

Appl. No. 10/659,415  
Amdt. dated April 4, 2006  
Reply to Office action of Jan. 18, 2006

### Remarks/Arguments

Applicants thank Examiner Johnson for his careful examination of this application and his clear explanation of the claim rejections. In response to the Office Action of January 18, 2006, applicants cancel claims 16-20. Regarding claims 9-15, applicants respectfully submit that because the Shalon patent does not disclose all the claim elements in claims 9-15, the rejections are improper:

#### Claim 9

Claim 9 describes a system for stud bumping. The system comprises a bonding head having a plurality of wire passages and a plurality of wires disposed through respective ones of the plurality of wire passages.

Contrarily, the Shalon patent discloses printing systems and methods for depositing small volumes of liquid on solid substrates.<sup>1</sup> The Office Action rejects claim 9 as anticipated by the Shalon patent because "Shalon teaches a bonding head having a plurality of wire passages formed therein; where the capillary tips are capable of having wires disposed through the passage..." The Office Action recognizes that the Shalon patent does not disclose the elements of a plurality of wires disposed through respective ones of the plurality of wire passages but argues that "It is the examiner's position that the wire is a process limitation that holds little patentable weight in the apparatus claim."

Applicants respectfully submit that it is long established that "to anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."<sup>2</sup> The Examiner's position notwithstanding, the law clearly requires that every element of the claim be disclosed in the reference. Because the Shalon patent fails to disclose the plurality of wires element, it does not anticipate claim 9 and claim 9 stands patentable over the Shalon patent.

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<sup>1</sup> US 6,309,891 B1, Abstract.

<sup>2</sup> *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312 (Fed. Cir. 2006) quoting *General Electric Co. v. Nintendo Co.*, 179 F.3d 1350 (Fed. Cir. 1999)

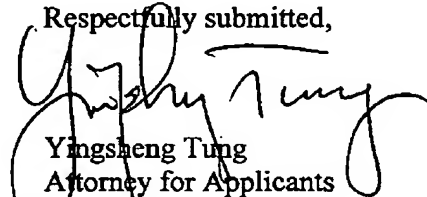
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Claims 10-15

Claims 10-15 properly depend from claim 9. Because claim 9 stands patentable, claims 10-15 stand patentable at least by virtue of their dependence.

Applicants respectfully request further examination of this application and timely allowance of all pending claims.

Respectfully submitted,



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